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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,511	10/06/2000	Raymond Andersen	P108281-0000	6795

7590 03/27/2002

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EXAMINER

LUKTON, DAVID

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 03/27/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/581,511

Applicant(s)
Andersen

Examiner
David Lukton

Art Unit
1653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 19, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) 19-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

Applicants' election of Group V with traverse is acknowledged.

Applicants have traversed the restriction by arguing that MPEP §1850 governs only the international stage and does not apply to the national stage. In other words, applicants appear to be arguing that the rules for "lack of unity" in international applications are radically different from the rules for "lack of unity" in national stage applications.

However, applicants have pointed to no authority for this. Applicants have also argued that Group II should be rejoined with the elected group. The examiner agrees, and this was stated preemptively in the Office action mailed 9/18/01. However, the rejoining will be deferred until it is determined what might be allowable within the elected group. Applicants have also requested that claims 20 and 21 be rejoined. However, it is probably the case that more than 90% of all embodiments within the scope of claims 20 and 21 are known in the prior art, many of them having been disclosed more than 20 years ago. For example, it would appear that simple mono-protected amino acids such as Fmoc-Ala-OH and Fmoc-Phe-OH are encompassed by claim 20. These were well known long before the file date of the instant application. "Unity of invention" between the compounds of claim 1 (on the one hand) and the compounds of claims 20-21 (on the other hand) is definitely lacking. The restriction is maintained at this time.

※

Claims 1-18 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 recites the following (page 31, line 22+):

“R₁ and R₂ are independently ... ArR-... and where... neither are ArR-”

Thus, a contradiction is apparent. Can either (or both) of R₁ and R₂ be ArR-, or not?

The same issue applies in the case of the definition of R₃ and R₄.

- In claim 18, the structure should be made more clear. It should be made clear that the isopropyl group is bonded to the allylic carbon atom, and not that there are two separate structures.

※

The following is a quotation of the appropriate paragraphs of 35 U.S.C §102 that form the basis for the rejections under this section made in this action.

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the

United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2) and (4) of section 371(c) of this title before the invention thereof by the applicant for the patent.

Claim 1 is rejected under 35 U.S.C. §102(e) as being anticipated by Webber (USP 6,214,799).

Webber teaches various compounds falling within the scope of claim 1. For example, at col 18, line 20+ a compound is taught. This corresponds to applicants' substituent variables as follows:

Y = -CH(R)CH=CH- wherein "R" is the side chain of glutamine;
Z = -O-C₂H₅;
R8 = hydrogen;
R7 = benzyl;
R6 = hydrogen;
R3 = hydrogen;
R5 = hydrogen;
R4 = alkyl;
R1 = hydrogen;
R2 = a benzyl group that is "substituted" with oxo (resulting in a benzoyl group)

Thus, the claim is anticipated.

✱

Claim 1 is rejected under 35 U.S.C. §102(b) as being anticipated by Molteni (US 4,048,305).

Molteni discloses compounds in col 1 line 8+. This corresponds to compounds in claim 1 in which Y, Z and R₇ are as follows:

Y = a methine group substituted with methylene-imidazole

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-5-

Z = hydroxyl

R₇ = benzyl

Thus, the claim is anticipated.

✱

Reference "AG" was stricken from the IDS because a copy was not received.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



DAVID LUKTON
PATENT EXAMINER
GROUP 1800